

### **Remarks/Arguments**

This Response is provided in response to the non-final Office Action mailed September 23, 2008, in which the Examiner rejected claims 8-14 under 35 U.S.C. §103(a) as being unpatentable over prior art.

### **Rejection of Claims 8-14 Under 35 U.S.C. §103(a)**

In the Office Action mailed September 23, 2008, the Examiner rejected claims 8-14 under 35 U.S.C. §103(a) as being unpatentable over United States Design Patent No. D246,282, issued to Dennis B. Jackson (Jackson '282) in view of United States Design Patent No. D119,400, issued to O. E. Skelton (Skelton '400). The Applicant respectfully traverses this rejection.

As the Examiner will appreciate, the Supreme Court has recently clarified the law with regard to obviousness determinations. See *KSR International Co. v. Teleflex Inc.*, 82 USPQ2d 1385 (2007). In *KSR*, the Court rejected a rigid application of the so-called teaching-suggestion-motivation (TSM) test in favor of a more flexible approach to the inquiry based on the factors set forth by *Graham v. John Deere*, 363 US 1 (1966). Generally, the so-called teaching-suggestion-motivation (TSM) test is still available for use, so long as it is not rigidly applied in a formulistic sense. *KSR* at 1399.

In all cases, the obviousness determination cannot be based on merely conclusory statements; rather, there must be “*some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.*” *KSR* at 1396, quoting *In re Kahn*, 78 USPQ2d 1329 (Fed. Cir. 2006).

In the present case, the Examiner found the skilled artisan would be motivated to arrive at the claimed subject matter over Jackson '282 in view of Skelton '400, stating:

*“Jackson provides a hand implement in the form of a knife handle intended to be used with a blade; and a handle comprising a main body portion; and an appendage support member projecting laterally from the main body portion, the appendage support member comprising a top surface that provides a concave recess wherein a principle axis of the concave recess passing through a center of curvature and inherently having a vertex of the concave recess is substantially perpendicular to and offset from a centerline of the main body portion.”* Office Action mailed September 23, 2008, page 2, lines 6-12.

This is respectfully traversed on the basis that (1) Jackson '282 fails to teach or suggest each of the claim limitations as properly construed, (2) Skelton '400 fails to teach or suggest each of the claim limitations as properly construed, and (3) there is no evidence that the skilled artisan would have a reasonable expectation of success in making the proposed combination.

Jackson '282 fails to expressly or inherently identically show the limitations of: “an appendage support member projecting laterally from the main body portion, the appendage support member comprising *a top surface that provides a concave recess wherein a principle axis of the concave recess passing through a center of curvature and a vertex of the concave recess is substantially perpendicular to and offset from a centerline of the main body portion*, and the appendage support member having a substantially continuous convex shaped surface over a majority of the bottom surface to provide an ergonomic support surface for an appendage of a user.”

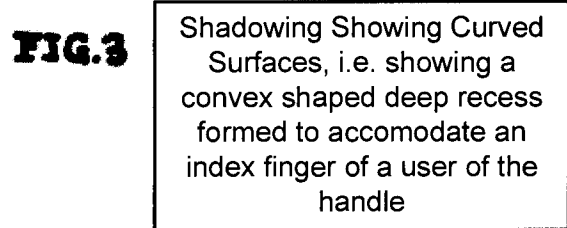
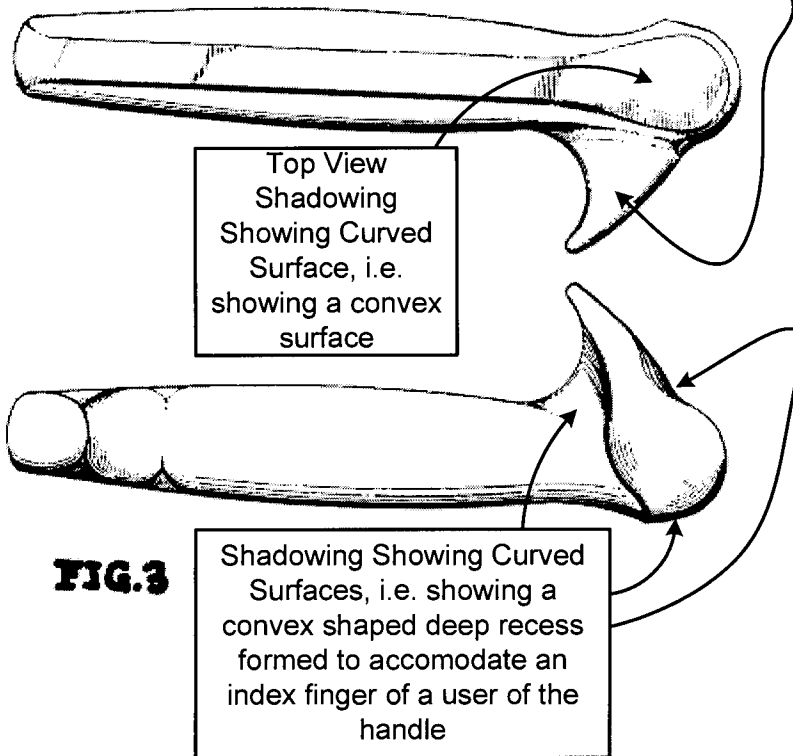
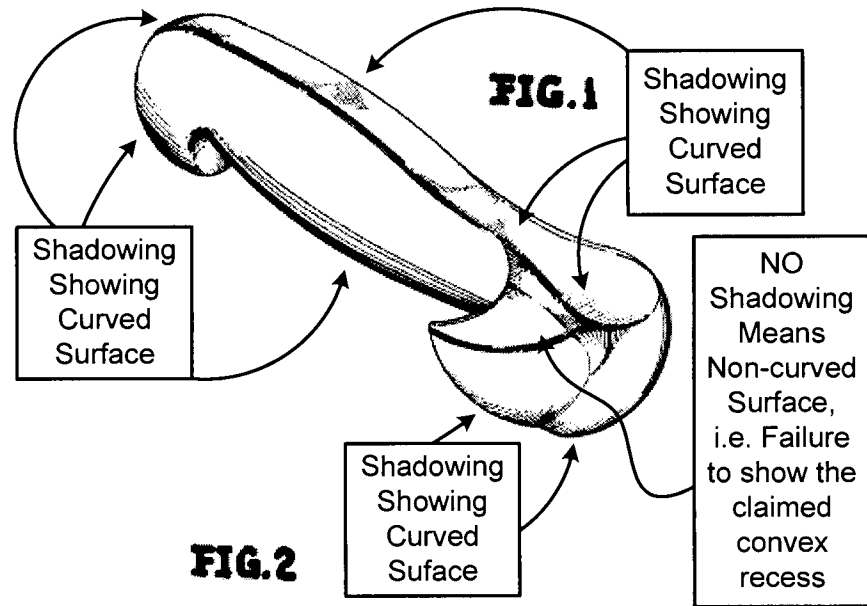
**The cited reference fails to show an** appendage support member comprising a top surface that provides a concave recess wherein a principle axis of the concave recess passing through a center of curvature and a vertex of the concave recess is substantially perpendicular to and offset from a centerline of the main body portion **as recited by independent claim 8**. In fact, the concave recess wherein a principle axis of the concave recess passing through a center of curvature and a vertex of the concave recess is substantially perpendicular to and offset from a centerline of the main body portion, is illustrated at least in figures 4, 5, 6 and 8.

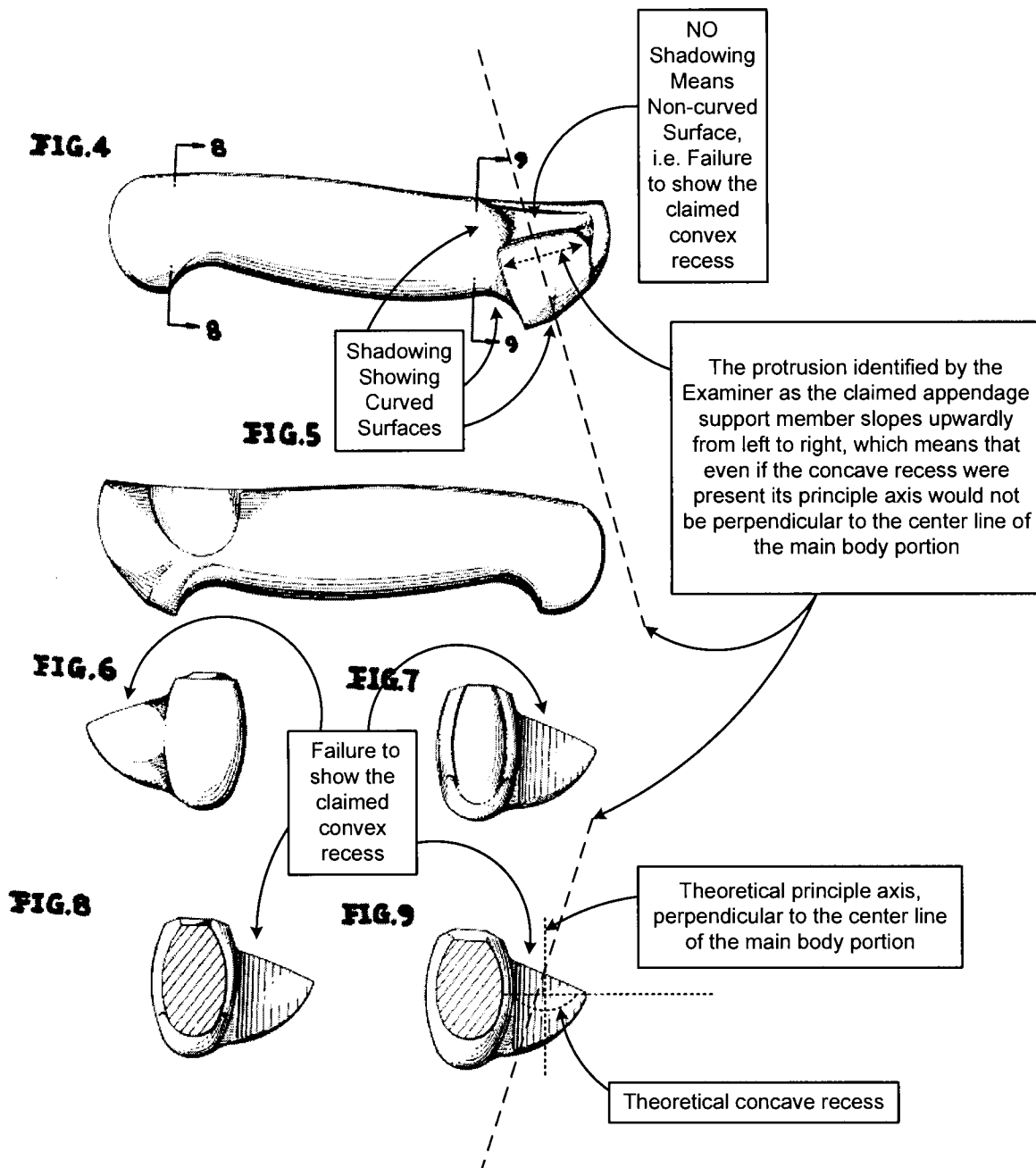
The Examiner has pointed specifically to Figure 1 of Jackson '282 as teaching “an appendage support member comprising a top surface that provides a concave recess wherein a principle axis of the concave recess passes through a center of curvature and inherently having a vertex of the concave recess.”

As shown below by the reproduced drawing figures of Jackson '282, neither a concave recess nor a principle axis of the concave recess passing through a center of curvature and a vertex of the concave recess is substantially perpendicular to and offset from a centerline of the main body portion is expressly or inherently identically show by Jackson '282. It is clear that the Applicant knew the need and function of shadow lines to identify inventive features of a Design Patent. A skilled artisan understands that the only disclosure of any substance is the drawings that accompany the statutory language of the

claim for a Design Patent. Explicitly, the drawings taken in total provide what constitutes the invention, and therefore the drawings constitute what is shown by the prior art.

As can be seen below, Jackson '282 fails to provide shadowing identifying a concave surface on the appendage support member projecting laterally from the main body. FIG. 4 shows the protrusion identified by the Examiner as the claimed appendage support member slopes upwardly from left to right, while FIGS. 6, 7, 8, and 9 show the appendage support member sloping downwardly from left to right away from the main body, which means that even if the concave recess were present, which it is not, its principle axis would not be perpendicular to the center line of the main body portion.





As clearly shown in FIG. 3, and well understood by a skilled artisan, the width of the appendage support member of Jackson '282 would not accommodate the claimed appendage support member, nor would the depth of the appendage support member as shown by FIG. 4 of Jackson '282 accommodate the claimed appendage support member. The reason the appendage support member of Jackson '282 could not accommodate the claimed appendage support member is seen by viewing a hypothetical, or theoretical concave recess of FIG. 9, shown above. The depth and width of the hypothetical or theoretical concave recess would cause a break-out of the front and back side walls of the

appendage support member of Jackson '282, breakouts that are not shown by FIGS. 6, 7, 8, and 9. In particular, the deep recess provides by Jackson '282 for a users index finger, as shown by FIG. 3, removed material that would be required to provide the claimed appendage support member.

Similarly, the Skelton '400 reference fails to teach or suggest all the claimed limitations of the present embodiment. Indeed, Skelton '400 also fails to accommodate the deficiencies of Jackson '282 to teach or suggest the claimed embodiment to a skilled artisan. The Examiner has stated "Skelton teaches the general concept of an ergonomically shaped handle grip with a knife blade attached thereto." See Office Action, page 3, lines 4-5. While an ergonomic handle is shown in Skelton '400, the failure to teach or suggest "a top surface that provides a concave recess wherein a principle axis of the concave recess passing through a center of curvature and a vertex of the concave recess is substantially perpendicular to and offset from a centerline of the main body portion" as claimed, critically fails to meet the minimum threshold for sustaining an obviousness rejection.

That is, one skilled in the art would not logically interpret the Skelton '400 reference to teach or suggest the support member having a "top surface that provides a concave recess," as claimed. At best, Skelton '400 teaches an ergonomic handle that is easy to hold, but provides marginal downward cutting force due to the forward facing curved appendage. Hence, a skilled artisan would not reasonably arrive at the claimed embodiment that vastly improves downward force applied on the knife's edge from the design of Skelton '400.

Therefore, neither Jackson '282 nor Skelton '400 reasonably teaches or suggests every limitation recited in independent claim 8.

Furthermore, Jackson '282 and Skelton '400 fail to provide the required motivation to one skilled in the art to combine the references to arrive at the claimed invention. A skilled artisan can reasonably interpret Jackson '282 to provide a handle extension to aid in applying downward force to the handle. Conversely, Skelton '400 can only be interpreted to aid in lateral control of the handle. This fundamental difference between the cited references illustrate that the designs teach away from one another and would not be logically combined in order to arrive at the embodiment of claim 8.

In addition, the juxtaposed teachings of the cited references in relation to the position of a blade would never provide motivation to a skilled artisan to combine the

references. In FIG. 4 of Skelton '400, a skilled artisan would clearly notice the skewed orientation of the blade in relation to the ergonomic handle components. The angled relationship between the handle features and the blade would be interpreted by a skilled artisan as providing little or no assistance in applying downward pressure to the knife's edge. In contrast, Jackson '282 shows a handle extension that has a top surface oriented so that downward force could be placed on the handle. However, only assumptions can be made as to where a blade would be placed on the Jackson '282 handle due to the lack of an embodiment featuring a blade.

Nevertheless, one skilled in the art would never logically find motivation to combine the skewed handle extension of Skelton '282 with predominately lateral support with the downward force assisting handle extension of Jackson '282 to arrive at the embodiment of claim 8.

In sum, the cited references fail to teach or suggest all the claimed limitations of the present embodiment to one skilled in the art. Likewise, a skilled artisan would find no motivation or desire to combine the cited references to arrive at the claimed embodiment. Specifically, one skilled in the art would fail to arrive at the claimed limitation of an "appendage support member comprising a top surface that provides a concave recess wherein a principle axis of the concave recess passing through a center of curvature and a vertex of the concave recess is substantially perpendicular to and offset from a centerline of the main body portion."

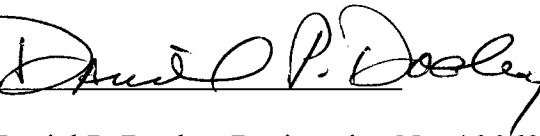
Indeed, the only reasonable explanation of the Examiner's combination of the combination of the contrasting designs of Jackson '282 and Skelton '400 is improper hindsight reconstruction. See MPEP 2141. As such, the Applicant respectfully requests reconsideration and allowance of independent claim 8, as well as dependent claims 9-14, for these reasons.

**Conclusion**

The Applicant respectfully requests reconsideration and allowance of all of the claims pending in the application. This Response is intended to be a complete response to the non-final Office Action mailed September 23, 2008.

Should any questions arise concerning this response, the Examiner is invited to contact the below listed Attorney.

Respectfully submitted,

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